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REMARKS

Claims 1-25, 36-40 and 43 are currently pending in the subject application and are presently under consideration. Claims 26-35, 41 and 42 stand withdrawn. Claims 2, 23 and 38 have been cancelled, independent claim 1 has been amended to recite the limitations of claim 2 and independent claims 21 and 36 have been amended to recite limitations disclosed in claim 8. In addition, claims 6, 8-10, 12, 14-16 and 25 have been amended herein to correct minor informalities. It is noted that none of these amendments necessitate a new search or any undue effort by the Examiner as they do not present new claimed subject matter.

Applicants' representative would like to thank the Examiner for the courtesies extended during the phone interview on August 24th, 2005. As discussed, Wolff does not teach or suggest the limitations of dependent claims 2 and 8 (which have been incorporated into independent claims 1, 21 and 36). Accordingly, as you indicated, any subsequent Office Action should be accorded the status of non-final.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-5, 7-16, 18-25, 36-40 and 43 Under 35 U.S.C. §103(a)

Claims 1-5, 7-16, 18-25, 36-40 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wolff (US 6,185,601) of record in view of Facemire *et al.* (US 2005/0091340 A1). Withdrawal of this rejection is respectfully requested for at least the following reasons. The cited references, either alone or in combination, fail to teach or suggest all limitations of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. *First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.* Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of

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success must be found in the prior art and not based on the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

The claimed invention relates to facilitating persistent caching across network connectivity interruptions. In particular, independent claim 1 recites *one or more surrogate providers comprising at least a first surrogate provider that is a client side caching (CSC) component that selectively caches at least a subset of data from at least one online server and supports connection state transitions at the directory level on a logical namespace*. Wolff and Facemire *et al.* fail to disclose such novel features of the subject claims.

Wolff relates to a method for load rebalancing of client computer requests in a network environment. Wolff allows for a client computer to request access to a resource from a memory resource associated with one or more server computers. In the event that a first server computer has reached a utilization threshold with respect to resource requests, subsequent requests can be re-directed to a less-utilized server.

On page 3 of the Office Action (dated June 2, 2005) with regard to claim 2, it is erroneously contended that Wolff shows the claimed limitation of a *client side caching component that supports connection state transitions at the directory level on a logical namespace*. At the portions of Wolff indicated by the Examiner, the reference shows a logical name driver module that provides for a persistent view of a resource in a network namespace. However, this portion of Wolff does not relate to any type of a surrogate provider, let alone client side caching. In fact, the Examiner concedes that Wolff does not teach surrogate providers for offline use, so it would be impossible for the reference to provide a client side caching component (*i.e.* surrogate provider) that supports connection state transitions. Instead, the indicated portion of the document is simply directed towards utilizing logical namespaces in the typical fashion of presenting a persistent view of a resource over a network.

Moreover, independent claims 21 and 36 and dependent claim 8 recite similar limitations as independent claim 1, namely *selectively caching one or more file objects and a logical namespace associated with the one or more file objects from at least one online server to the respective data store for subsequent offline use by the client computer*. Since Wolff fails to support connection state transitions at the directory level on a logical namespace, the reference is

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further silent with respect to caching the logical namespace associated with the one or more file objects from at least one online server to a client computer.

Facemire *et al.* fails to compensate for the aforementioned deficiencies of Wolff.

Facemire *et al.* allows for storing content from a server in a client side cache. The reference subsequently generates a pathway navigation map (PNM) that maps the content in the client side cache. Thus, Facemire *et al.* provides the PNM to navigate *within* the cached content, but is silent with respect to caching the logical namespace *associated with the server* from which the content was retrieved. Consequently, Facemire *et al.* is silent with respect to the claimed limitation of selectively caching one or more file objects ***and a logical namespace associated with the one or more file objects from at least one online server.***

Furthermore, the prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F.2d at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985). Wolff is directed towards server load rebalancing and resource sharing amongst numerous client computers, and does not relate to utilizing any type of a surrogate provider to facilitate offline use of data across connectivity states. Thus, combining the pathway navigation map as taught by Facemire *et al.* with the teachings of Wolff is inappropriate. The Examiner's rationale proffered to combine such teachings is to achieve benefits identified in applicant's specification, to overcome problems associated with conventional methods, etc. This is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicant's specification. This sort of rationale has been condemned by the CAFC; *see, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). ***One cannot use hindsight reconstruction to pick and choose***

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among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted and emphasis added).

In view of at least the foregoing, it is readily apparent that Wolff and Facemire *et al.* fail to teach or suggest all limitations of the subject claims. Accordingly, this rejection with respect to independent claims 1, 21 and 36 (and the claims that depend there from) should be withdrawn.

II. Rejection of Claims 6 and 17 Under 35 U.S.C. §103(a)

Claims 6 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wolff of record in view of Facemire *et al.* and further in view of Shaw *et al.* (US 2002/0083148) of record. This rejection should be withdrawn for at least the following reasons.

The subject claims depend from independent claim 1. As previously discussed, Wolff and Facemire *et al.* fails to teach or suggest all the limitations of claim 1. Shaw *et al.* fails to make up for the deficiencies of Wolff and Facemire *et al.* Shaw *et al.* relates to a system that accesses and acquires data from a content provider that relates to personal profile information of an end user (e.g. client computer). This data is stored at a cache located near the client computer. The system allows the user of the client computer in an online gaming environment to access their user profile from the nearby cache instead of from the content provider itself, thus allowing online gaming content to be provided to the user in a rapid manner. However, Shaw *et al.* makes no mention of a surrogate provider that stores data at one or more client computers as in applicants' claimed invention, let alone supporting connection state transitions at the directory level on a logical namespace, as claimed. Therefore, this rejection should be withdrawn.

10/692,212MS306620.01/MSFTP527US**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP527US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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